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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/419,752	10/16/1999	PETER AR-FU LAM	ESY2A	1738

7590 06/05/2002

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EXAMINER

DORVIL, RICHEMOND

ART UNIT	PAPER NUMBER
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2654

DATE MAILED: 06/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/419,752

Applicant(s)

LAM, PETER AR-FU

Examiner

Richemond Dorvil

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 January 1985.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Drawings

1. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing.

Specification

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 1-91 have been renumbered as claims 1-85.

3. The disclosure is objected to because of the following informalities: the specification contains a brief description of drawings but these drawings were not filed.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-85 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-85 define non-statutory processes because they merely manipulate an abstract idea (mathematical algorithm) without a claimed limitation to a practical application.

The disclosed invention has a practical application in the technological arts; however, the claimed process, a series of steps to be performed on a computer, simply manipulates an abstract idea without a claimed limitation to a practical application and does not have any post or pre-computer process activity.

A review of application 09/419,752 shows the disclosed invention thereof to be a method for programming a computing device. This is a practical application within the technological arts. However, it does not disclose specific hardware, specific software, or a combination thereof for performing the claimed functions.

The claims, each taken as a whole, are directed to an abstract idea that is not applied to or limited by other physical elements or process steps. Arrhythmia Research Technology, Inc v. Corazonix Corp., 958 F.2d 1053, 22 USPQ 2d 1033 (Fed. Cir. 1992).

In the instant application the disclosure is directed to any and every structure for carrying out the claimed functions, and not solely to specific structure for performing the claimed functions. Claims 1-85, reviewed in light of the specification, simply recite a sequence of steps to execute one or more events.

Claims 1 and 85 are written in means-plus-function format and for the purpose of this rejection are being treated as though they were method claims. The courts have held that such treatment is acceptable:

"If the functionally-defined disclosed means and their equivalents are so broad that they encompass any and every means for performing the recited functions, the apparatus

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claim is an attempt to exalt form over substance since the claim is really to the method or series of functions itself. In computer-related inventions, the recited means often perform the functions of "number crunching" (solving mathematical algorithms and making calculations). In such cases the burden must be placed on the applicant to demonstrate that the claim is truly drawn to specific apparatus distinct from other apparatus capable of performing the identical functions."

If this burden has not been discharged, the apparatus will be treated as if it were drawn to the method or process which encompasses all of the claimed "means." See In re Abele 214 USPQ 682, 688 (CCPA 1982); Ex parte Akamatsu, 22 USPQ 2d 1915, 1920; and Ex parte Alappat, 23 USPQ 2d 1340, 1344.

The specification does not disclose a specific hardware, software, or a combination thereof for performing the steps of specifying user defined custom expressions, defining x qualifying instructions etc. Claims 41 and 88 recite a first and second processor and computing means respectively however, these are only general computing devices.

Taking each claim as a whole, we have field of use limitations claim 1-85. These limitations do not in any way further limit the algorithm.

As per the claims, the language "A method to program a computing device", for example, does not transform the claimed subject matter into statutory subject matter. The recital is merely a field of use or desired end use limitation.

An abstract idea is not made statutory by "attempting to limit the use of the formula to a particular technological environment." Diehr, 450 U.S. at 191, 209 USPQ at 10. Thus, "field of use" or "end of use" limitations in the claim preamble are insufficient to constitute a statutory process.

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This is consistent with the usual treatment of preambles as merely setting forth the environment. See Flook (the preamble, while limiting the application of the claimed method to "a process comprising the catalytic chemical conversion of hydrocarbons" did not serve to render the method statutory); Walter 618 F.2d at 769, 205 USPQ at 409 ("Although the claim preambles relate the claimed invention to the art of seismic prospecting, the claims themselves are not drawn to methods of, or apparatus for seismic prospecting")' de Castelet, 562 F.2d at 1244 n.6, 195 USPQ at 446 n.6 ("the potential for misconstruction of preamble language requires that compelling reason exist before that language may be given weight). Compare Waldbaum, 559 F.2d at 616 n.6, 194 USPQ 469 n.6 ("Portion of preambles referred for completeness of the claims and are proper limitations thereto").

The court has held that a field of use limitation cannot make a claim statutory by "attempting to limit the use of the formula to a particular technological environment. "Diamond v. Diehr 209 USPQ 1, 10 (s. CT 1981) Thus, the field of use limitation of a programming method ... fails to render the claims statutory.

The above review of the claims shows that the subject matter claimed in addition to the abstract idea is not sufficient on its own to render the claims as a whole statutory.

Further, a review of each claim as a whole fails to show the transformation or reduction of subject matter to a different state or thing.

It is readily apparent that when claims 1-85 are each taken as a whole, the claims are directed to the preemption of an abstract idea and, thus, are non-statutory.

Conclusion


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5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richemond Dorvil whose telephone number is (703) 305-9645. The examiner can normally be reached on Tuesday-Friday 9:30AM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 308-5576. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 3059508 for regular communications and (703) 308-9051 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


Richemond Dorvil
Primary Examiner
Art Unit 2654

RD
June 2, 2002